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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,807	01/25/2002	Jon Ocel	M190.134.101	9381
27581	7590	03/03/2009		
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER GIBSON, ROY DEAN	
			ART UNIT	PAPER NUMBER
			3739	
			MAIL DATE	DELIVERY MODE
			03/03/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,807	<b>Applicant(s)</b> OCEL ET AL.	
	<b>Examiner</b> Roy D. Gibson	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54 and 56-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54 and 56-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/17/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54, 56-65 and 67-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritzsich (5,441,499) in view of Witt et al. (US 2002/0107517).

Regarding claims 54 and 71, Fritzsich discloses a medical device for use in a medical procedure comprising:

a manually graspable handle (Figure 1, # 35);

an elongated shaft (11) projecting from the handle, the shaft being sized and shaped to be positioned through a small incision in the chest of a patient and defining a proximal section comprising a rigid, elongated metal tube and a distal section comprising metal and a rounded distal tip portion (Figure 9, # 14) adapted to be slid relative to tissue, the shaft including a joint comprising a pin (Figure 9) that moveably couples the distal section to the proximal section thereby allowing the distal section to pivot relative to the proximal section;

a non-conductive material (Figure 3, # 43) surrounding at least a portion of the elongated shaft;

a remote actuator (Figure 1, # 36) proximal the distal section for selectively controlling the actuation of the joint;

Art Unit: 3739

a power source; and

a switch located on the medical device for activating the delivery of electrical power from the power source, wherein the light is visible when power is being delivered (col. 4, line 23-5, line 65, col. 6, line 56-col. 7, line 33).

But, Fritzsche fails to specifically disclose the power source is a battery and a light located on the medical device and electrically coupled to the power source.

Regarding the battery, the examiner notes that the MPEP 2144.04, V, A “Making Portable”, teaches that this is an example directed to a common practice which the court has held normally requires only ordinary skill in the art and hence is a considered a routine expedient. In making the power source portable it would have been obvious to replace the power supply of the RF generator of Fritzsche with a battery and inverter (DC-AC). Regarding the light located on the medical device and which is visible when power is being delivered, Witt et al. teaches this limitation in [0090 and 0092] wherein the feedback light (327) is in close proximity of the target area and provides the operator with a clear indication of when tissue has been sufficiently desiccated. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Fritzsche, as taught by Witt et al. to provide a light that is visible when the power is being delivered.

Regarding claims 56-59, Fritzsche discloses the distal section includes a passage and an opening or, as a design choice, a slot (Figure 9).

Art Unit: 3739

Regarding claims 60-63, Fritzsich discloses the actuator comprises a knob and the optional claims of a button, lever or slide are merely obvious design choices for one of ordinary skill in the art.

Regarding claims 64 and 65, Fritzsich discloses wherein at least a portion of the distal section of the elongated shaft defines a uniform radius of curvature (Figures 1-9); and wherein the handle is rigidly coupled to the shaft such that the shaft is readily manipulated via movement of the handle (Figure 1).

Regarding claims 67-70, Fritzsich discloses wherein the actuator is located at the handle;

wherein the proximal section includes an internal lumen (Figure 3, # 37);

wherein at least a portion of the shaft is malleable (Figure 3); and

wherein the medical procedure is capable of an ablation procedure (RF electrode 13 and col. 1, lines 35-36).

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fritzsich and Witts et al. and further in view of Swanson et al. (6,123,702). Neither Fritzsich nor Witts et al. discloses a sensor located at the distal section of the elongated shaft. But, Swanson et al. disclose a system for controlling power in an electrosurgical probe wherein a sensor ((Figure 1, # 120) is located at the distal section and provides a signal for temperature control of the RF source (col. 7, lines 1-17). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the

Art Unit: 3739

device of Fritzsche/Witts et al., as taught by Swanson et al., to provide a sensor for measuring temperature at the distal section of the shaft or probe.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on Tu-Th, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy D. Gibson/  
Primary Examiner  
Art Unit 3739

February 26, 2009

Application/Control Number: 10/056,807  
Art Unit: 3739

Page 6